

Application No.: 10/654,179  
Response to Office Action of June 1, 2006  
Attorney Docket: BEIRU-001A

**Amendments to the drawings:**

Applicant respectfully request entry of new Figure 5A which illustrates depressions formed in the bottom surface of the insole. Applicant has submitted concurrently herewith replacement sheets for Figures 4, 5, 5A, 6, 6a, 7, 8, 9 and 10, as shown in Exhibit A. Previously, Figures 4, 5 and 6 were on a single sheet; currently, Figures 4, 5 and 5A are on a single sheet. Previously, Figures 6a, 7, 8, 9 and 10 were on a single sheet; currently, Figures 6 and 6A are on a single sheet and Figures 7, 8, 9 and 10 are on a single sheet.

## **REMARKS**

This is a response to the Office Action of June 1, 2006.

### **I. SUMMARY OF OFFICE ACTION**

In the Office Action, Claims 1 and 11 were rejected under 35 U.S.C. §102(b) as being anticipated by Skaja. Claims 1-16, 11-12 and 15-16 were rejected under 35 U.S.C. §103(a) as being unpatentable over Jurgens in view of Lenke. Claim 7 was rejected under 35 U.S.C. §103(a) as being unpatentable over the references as applied to the claims above, and further in view of Louie (U.S. Patent No. 6,470,600). Claim 10 was also rejected under 35 U.S.C. §103(a) as being unpatentable over the references as applied to the claims above, and further in view of Bouchoms.

Claims 8-9, 13-14 and 17-18 were merely objected to as being dependent upon a rejected base claim but indicated that these claims would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Also, the Examiner indicated that Claims 19-25 were allowable.

### **II. APPLICANT'S RESPONSE**

#### **A. Claim 1**

In the Office Action, the Examiner rejected Claim 1 under 35 U.S.C. §102(b) as being anticipated by Skaja and also under 35 U.S.C. §103(a) as being unpatentable over Jurgens in view of Lenke. Applicant has broadened Claim 1 by replacing the term "plurality" with the phrase "at least one."

In response to the rejection of Claim 1, Applicant has amended Claim 1 to recite that the pressure nub is centrally disposed on and outwardly projected from the concave surface of the cups. According to amended Claim 1, the cups and the nubs must both be projected outwardly (i.e., projected in the same direction). Applicant respectfully submits that the cups and nubs shown in Skaja are not projected outwardly or projected in the same direction. In particular, as shown in Figure 18, if nubs 53 are characterized as being projected outwardly, then the cups must be characterized as being projected inwardly or vice versa.

There is also no motivation to modify the device of Skaja such that the concave surface of the cup and the pressure nub are projecting outwardly. The reason is that to do so would make the reference inoperable for its intended use. As understood, the nub 53 interlocks with the cup

51. If the concave surface of the cup 51 and the nub 53 were oriented so as to be projecting outwardly or in the same direction, then the nub would not be able to fit within the cup or interlock with each other. In support thereof, Applicant respectfully directs the Examiner's attention to Figures 16-18 and Column 14, Line 51-Column 15, Line 4 of the specification of Skaja. As shown and described, the sole may be attached to the upper in a variety of ways. One way is shown in Figures 16-18 wherein the nub 53 is received into the cup 51. As understood, the nub 53 snaps into the cup 51 but resists separation due to the angular orientation of the arrow-shaped head of the nub 53. Accordingly, modifying the device of Skaja such that the cups and nubs are both projected outwardly or in the same direction would make the device of Skaja inoperable for its intended use. Moreover, the nub 53 and cup 51 of Skaja are not for the purposes of massaging and reflexology but is solely used for the purposes of interlocking the sole and the upper. Hence, Skaja does not disclose, suggest or make obvious the invention recited in Claim 1.

Additionally, the combination of Jurgens and Lenke does not disclose, suggest or make obvious the invention recited in Claim 1. Jurgens does not disclose a concave surface of the cup which is projected outwardly from the top surface of the core body. Rather, the concave surface of the cup is recessed within the core body and below the top surface thereof.

There is also no motivation to modify the Jurgens device such that the concave surface of the cup projects outwardly from the top surface of the core body. Col. 1, lines 20-29 of Jurgens teach that the Jurgens device has an object to avoid overstimulation. For example, at col. 2, line 59, the Jurgens disclosure discloses that the maximum total number of depressions is three. As understood, the low number of total depressions is to prevent overstimulation. Accordingly, if the Jurgens device was modified such that the concave surface of the cup projected outwardly from the top surface of the core body as shown in Lenke, then overstimulation of the foot may occur, as understood. The Jurgens disclosure teaches that such situation is preferably avoided. As such, the Jurgens disclosure teaches away from the combination of Jurgens and Lenke (i.e., modifying Jurgens such that the cup projects outwardly from the top surface of the core body).

Moreover, in Lenke, the nubs are not centrally disposed on the concave surface of the cups. Rather, the nubs are alternated with the cups. Accordingly, Lenke does not teach, suggest

or make obvious the limitation that the pressure nub be centrally disposed on and outwardly projected from the concave surface of each one of the cups.

For the foregoing reasons, Applicant respectfully submits that Claim 1 is not disclosed, suggested or made obvious by the cited prior art. Thus, Claim 1 is believed to be in condition for allowance. The dependent claims of Claim 1, namely Claims 2-18 and new Claims 26 and 27 are also believed to be in condition for allowance for containing additional patentable subject matter.

For example, new Claim 26 recites at least one depression formed in the bottom surface of the core body and new Claim 27 recites that the depression is aligned to the cup and pressure nub. The basis for new Claims 26 and 27 are found in paragraphs 71 and 72 of the instant specification as originally filed. Hence, new Claims 26 and 27 do not introduce new matter. New Figure 5A has been added to clarify and better show the depressions that are being claimed in Claims 26 and 27.

New Claims 26 and 27 are believed to be in condition for allowance for containing additional patentable subject matter. The depression formed in the bottom surface of the core body is for the purpose of providing a pneumatic spring effect so as to absorb shock forces that would otherwise be absorbed by the user's knee, ankles and legs and body into the depressions. In particular, the bottom surface of the core body mates with the inside of the shoe sole. As such, the depression forms an air bubble defined by the core body and the shoe sole. When the user walks, downward forces are applied to the air bubble. The compressibility of the air within the air bubble absorbs the shock produced by the user. Additionally, the depression forms or behaves as suction cups which maintains the position of the core body with respect to the shoe such that while the user walks, the core body does not shift around within the shoe. The cited prior art does not disclose, suggest, or make obvious the depressions claims in or recited in Claims 26 and 27. Hence, Claims 26 and 27 are believed to be in condition for allowance for containing additional patentable subject matter as well as the other dependent claims of Claim 1, namely, Claims 2-18. The dependent claims of Claim 1, namely Claims 2-18, 26 and 27 are also believed to be in condition for allowance for being dependent upon an allowable base Claim 1.

#### **B. Claims 19-25**

In the Office Action, Claims 19-25 were deemed to be allowable.

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**C. Cited Prior Art**

Applicant acknowledges receipt of the prior art made of record and not relied upon, but considered by the Examiner to be pertinent to Applicant's disclosure. Applicant respectfully submits that the cited prior art, either alone or in combination, does not anticipate, suggest or make obvious the instantly claimed invention.

**D. Drawings**

Applicant respectfully request entry of new Figure 5A. (see Exhibit A).

**III. CONCLUSION**

For the foregoing reasons, Applicant respectfully submits that all the stated grounds of rejections and objections have been overcome and that Claims 1-27 are in condition for allowance. An early notice of allowance is therefore respectfully requested.

Should the Examiner have any suggestions for expediting allowance of the application, the Examiner is invited to contact the Applicant's representative at the telephone number listed below.

If any additional fee is required, please charge Deposit Account Number 19-4330.

Respectfully submitted,

Date:

8/14/06

By:



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